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07/273,669 11/18/88 CHENARD

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153

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10/05/89

This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.  \_\_\_\_\_

**Part II SUMMARY OF ACTION**

1.  Claims 1 to 19 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1 to 77, 79 to 91, 93 to 108, 110 to 125, 135 to 140 and 142-191 are rejected.

5.  Claims 78, 92, 109, 126 and 141 are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. 070,503 <sup>9 and</sup>; filed on 8-28-79

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

**EXAMINER'S ACTION**

15.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Claims 71, 72, 76, 79-86, 90, 93-103, 107, 110-120, 124, 127-135, 139 and 142-191 are rejected under 35 U.S.C. 102a as being fully met by Japanese KoKai 56-2336 and Japanese KoKai 55-160,044.

As stated in the examiner's answer in the parent application 254,313 filed April 15, 1981 and appealed to the PTO Board of Patent Appeals and Interferences (paper no. 35 page 5) "Applicants do not specifically disclose the mono and di-organo tin mercapto acid ester halide of these references. Their claims stipulation however, that the organotin stabilizer can contain a Sn-halide link as well as the Sn-S link derived from reacting an organotin compound with a mercaptan or mercapto acid/ester indicates that such broad language encompasses references' tin stabilizers which are similarly used with mercapto esters.

It is considered that applicants having now presented for the first time in their series of foreign and US applications, specific referral to such organotin mercapto acid ester halides in the instant application

which was filled subsequent to the reference disclosures' publications, rejection as fully anticipated inventions under 35 USC 102 (a) is justified.

The assertion that the 37 CFR 1.131 declaration filed August 13, 1984 established that applicants were in possession of a generic concept encompassing the use of all known organotin stabilizers prior to the references' publications, is contradicted by the fact that applicant had contended during the grand parent application's prosecution that their organotin component's recitation, which was then couched in the even broader terminology "a metal containing stabilizer", was distinct from Gough's organotin borate. See attached exhibit A, page 2, third paragraph. This traversal was clearly untenable and is so even in this application inasmuch as the organotin stabilizer is specifically stated as possibly containing a Sn-O link, and no prohibition that the oxygen be further linked to boron is indicated in either the claims or the disclosure.

Having expressly abandoned the parent application for the purpose of filing this application in order to provide support for the broad tin stabilizer terminology and also ostensibly for purpose of avoiding Gough's organotin borate, Appellants are in no position to assert that they were in possession of a generic concept

in using any and all organotin compounds prior to the references' publications, independent of what other species their declarations espoused as having been earlier reduced to practice."

Applicants contended that their earlier foreign applications and parent application relate that they were possession of a generic invention in the organotin-mercapto ester stabilizer concept and that therefore the presence as an added stabilizer of an organotin halide such as now set forth on page 21 in the specification of this application would have been appreciated at that time. They relied on the Wowk US Patents and Larkin US Patent attached to Foure's 37 CFR 1.131 affidavit which accompanied the amendment dated December 23, 1923, paper No. 16, as evidence that organotin mercapto halides per se (Wowk) or organotin halides such as octyltin trichloride in combination with standard tin stabilizers such as butyl tin tri (isooctyl mercapto acetate) (Larkin) were known organotin stabilizers at that time for PVC resins." Their use in lieu of those species found in the French priority applications (di-n-octyltin bis(isooctyl mercapto acetate), a butyl stannoic acid/butyl thiostannoic acid copolymer, butyl stannoic acid and dibutyl tin bis (isooctyl mercapto acetate) is urged by applicants as having been appreciated as obvious equivalents for purposes of use with the mercapto ester.

Contrary to applicants counsels assertion (preliminary amendment and information disclosure statement at page 26), the Foure, Chenard and Mendelsohn declarations under 37 CFR 1.131 were also found wanting by the this appeal <sup>Board</sup> (decision dated June 25, 1987 page 6) in removing these references as they were found not to be commensurate with the references' disclosures in the scopes of each of 1) the organotin compounds and 2) the mercapto alkanol derived monocarboxylic acid ester contemplated.

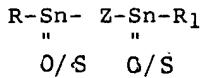
16.

The Kugele et al, U.S. patent no. 4360619 issued November 23, 1982 based on an application filed February 26, 1981 is not being applied against these claims, as it was in the parent application, inasmuch as Reexamination proceeding no. 90/000,583 resulted in the determination that the claims were invalid. See the REEXAM Certificate no. BI 4360619. Since that patent was being applied against claims wherein an auxilliary organotin halide e.g. dimethyltin chloride was also present along with the primary organotin stabilizer and mercapto alkanol derived carboxylate and such ternary component stabilizer system does not comprise the dual component stabilizer system of the Japanese references (of earlier publication dates than Kugele's effective filing date) applied in paragraph 15 supra, such patent claims' invalidation does not preclude the Japanese references' application for a different invention.

17.

Claim 71, 72, 76, 79-87, 90, 93-103, 107, 110-120, 124, 127-135, 139 and 142 to 191 are rejected under 35 U.S.C. 102b as being fully met by Bresser et al (984).

This US patent claims the use of a mercapto alkanol derived monocarboxylate and a bis (organotin) compound having the formula



wherein R and R<sub>1</sub> are each essentially hydrocarbyl and Z is a S,S' linked mono or di carboxylic acid ester radical.

Applicants foreign priority and earlier filed US applications are not seen to provide support for these S,S' carboxylic acid ester linked bis organotin compounds. Applicants species as well as generic formulas (page 15 and 16) do not encompass such compounds since all the compounds on page 16 are only -S- linking - tin- containing while those that do have a S, S' linking carboxylic acid ester group (page 15, line 16) do not contain any Sn= O/S bonding since R<sup>4</sup> is always hydrocarbyl.

18.

Claim 71-77, 85-91, 99-108, 115-125, 113-140, 148-149, 156, 163-166, 172-176, 183-184 and 191 are rejected under 35 U.S.C. 102a as being fully met by Kugele et al (114).

Applicants claims are broad enough to encompass the organotin halide and mercapto alkanol derived mercapto acid ester stabilizer system of this reference (claim 1 in col. 29 - component "B") for which aspect support is found in this application on page 8 vis - a - vis the G radical is -  $C^{\bullet} - R^3-SH$  and pages 14-16 for the organotin halide. See col. 15 of the Kugele patent.

Inasmuch as this invention is claimed by Kugele et al it can be obviated only by determining the first inventor through an interference proceeding. Applicant should copy any claim(s) which they believe can be made in order to initiate such proceeding.

19.

Claims 78, 92, 109, 126 and 141 are objected to as being dependent on rejected claims but would be allowed if placed in proper independent form.

20.

The unapplied references include those cited during the parent applications' prosecutions and most of those cited in Kugele US Patent 4360619. They will forwarded at applicants counsel's request. The Gough patent which is the earliest patent (US Patent 3928285 issued December 1975) suggesting mercapto alkanol derived carboxylic acid esters as an enhancer for any organotin heat stabilizer namely the organotin borates, teaches away from their use with organotin sulfur linked heat stabilizers since early color reduction and absence of

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Art Unit 153

sulfide odor are not obviated: col. 1, lines 44 to 66  
col. 8 lines 1 to 64 and col. 9 lines 11 and 12. Hence  
it is not being reapplied.

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GROUP 150 - ART UNIT 153